

### **REMARKS**

Applicants respectfully request reconsideration of the Office position set forth in the outstanding Final Office Action mailed June 3, 2003, in light of the foregoing amendments and the following remarks.

#### **Status of the Application**

Per the Official Action mailed June 3, 2003, claims 1-11 are pending in the above-referenced patent application; claims 1-8, 10 and 11 stand as rejected under 35 U.S.C. §102(b), and claim 9 stands as rejected under 35 U.S.C. §103(a). Support for amended claim 1 is provided by the described examples on pages 10, 11 and 12 of the present specification. No new matter has been added.

Applicants' Representative (Thomas R. Mancini, Reg. 50,157) had an interview with Examiner Michener via the telephone on August 6, 2003, and Applicants expressly thank the Examiner for her professionalism and explanation regarding Applicants' inquiry. A write-up of the interview accompanies this response.

The Examiner has asserted that the "comprising" language of Applicants' claims is open to the use of fabric backing films impregnated with resin and that such backing films are not excluded by Applicant's claims. Applicants submit that the amended claims do not encompass backing films having impregnated fabrics thereon as set forth by Smith et al.

#### **Rejections Under 35 U.S.C. §102**

Claims 1-8, 10 and 11 stand as rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,166,007 (Smith et al.). The Examiner asserts that Smith et al. teach a method for repairing vehicles, installations and parts using patch material on a fabric backing and also the preparation of a blemished area to be repaired prior to treating (column 2, line 45; column 4, line 14).

Applicants respond that Smith et al. fail to teach or suggest a method utilizing a backing film coated on one side with only an uncured or partially cured coating layer of a coating composition curable by means of high energy radiation, and therefore, Smith et al. teach very different subject matter than the present claimed invention.

Applicants wish to clarify their argument, in that both the present invention and Smith et al. teach the use of backing films, however, Smith et al. require the use of impregnated fabrics layered on the backing film rather than having only the coating composition on the backing film, as in the present invention. The Examiner has acknowledged this fact by noting that in Smith et al. "[b]acking films are coated with one or more photocurable resin impregnated fabric layers...." Specifically, in column 3, line 10 through column 8, line 63 as well as in Figure 1, Smith et al. teach a patch or repair assembly comprising:

- (a) a photocurable resin prepreg fabric;
- (b) a UV transparent release film on top of said prepreg fabric, and
- (c) an optional UV blocking film at least covering said UV transparent release film.

Thus, as taught by Smith et al., the resin impregnated fabric (a) is layered onto release film (b). As a result, the patch assembly described by Smith et al. is constructed where the bottom layer is fabric impregnated with a photocurable resin; a release film resides on top of this impregnated fabric layer, and a UV blocking film optionally resides on top of the release film. Alternatively, Smith et al. also teach the use of multiple photocurable resin impregnated fabric layers (see Figure 2). This use of an impregnated fabric is a fundamental difference that teaches away from the present invention.

In contrast to the teachings and suggestions of Smith et al., the process of the present invention utilizes only (a) a backing film; and (b) this backing film being coated on one side with a coating composition for repairing the substrate surface (see original and amended claim 1). The backing film in the present invention is coated with only the coating composition, such that, the impregnated fabric layers taught by Smith et al. are not required or even desired. This is further reinforced in amended claim 1 by requiring that the transferred layer is only the coating composition.

Furthermore, in column 8, lines 31-62, Smith et al. set forth the methods used for repairing vehicles, installations and parts. The disclosed methods require the application of at least the above-described patch, wherein several fabric layers may also be used. As a result, the repaired portion contains at least one impregnated fabric. While the Examiner is correct that Smith et al. indicate their described patch

may be used for repairing vehicles, Applicants maintain that the resultant repaired surface would not be of sufficient quality, particularly when compared to the present invention where the transferred layer is only the coating composition as required in amended claim 1 of the present invention

The process of the present invention results in smooth, optically flawless surfaces (see page 2, line 32 and page 12, lines 14-17 of the present specification). However, the repair process of Smith et al. is not applicable to spot repairs of a coated surface of a vehicle, particularly not to achieve automotive quality of the repaired surface. Smith et al. indicate that their repair process utilizing the fabrics is for use with the repair of tanks, containers, installations and pipes (see column 1, lines 7-10 and column 2, lines 27-29). Smith et al. make no indication that these articles have or require a smooth and bright finish or appearance without visible marks to the surrounding original coating and with comparable quality to the original coating. Thus, a patch assembly where after its application, a fabric remains in the coating composition, would not result in an optically flawless coating. Therefore, Smith et al. teach away from the present invention and do not teach or suggest the present invention, thus, Applicants respectfully request that the rejection be withdrawn.

#### **Rejections Under 35 U.S.C. §103**

Claim 9 stands as rejected under 35 U.S.C. §103(a) as being unpatentable over Smith et al. The Examiner asserts that Smith et al. teach that which is disclosed above regarding the use of UV irradiation to cure a repair resin on a blemished substrate, however, Smith et al. fail to teach an appropriate wavelength range for use in his irradiation process. The Examiner further asserts that selection of a wavelength range would have been dependent upon the type of substrate repaired, the coating materials used and the desired cure time, and thus, it is the Examiner's position that it would have been within the skill of an ordinary artisan to select an optimum wavelength range for UV curing to optimize results of the repair operation.

Applicants respond that, in addition to those arguments indicating where Smith et al. have failed to teach or suggest the present invention as presented above, Smith et al. teach a method wherein impregnated fabrics of woven fibers are

applied to the blemished area and requires the application of the prepreg fabric impregnated with UV-curable resin. However in the present invention a coating layer of a photocurable resin, for example, a clear or pigmented one layer top coat is applied to the blemished area using a removable backing film. This backing film is removed after application/curing in order to avoid spray application of the coating composition to only very small blemished areas. In the present invention only the coating layer remains on the repaired surface, whereas the method taught and suggested by Smith et al., at least one impregnated fabric remains on the substrate along with the coating composition, as the resin is incorporated into the fabric. Smith et al. do not teach or suggest that the use of their method results in only the coating composition remaining on the repaired surface, and thus, they do not teach or suggest the present invention. Therefore, since Smith et al. do not teach or suggest claim 1 of the present invention, and claim 9 depends from claim 1, Applicants respectfully request that this rejection of claim 9 be withdrawn.


**Summary**

For all of the reasons noted above, Applicants do not believe that the cited reference renders the Applicants' claimed invention as anticipated under 35 U.S.C. §102, or in the alternative, as obvious under 35 U.S.C. §103. It is respectfully requested that this rejection be withdrawn.

In view of the foregoing remarks, Applicants submit that the Examiner's rejections under §102(b) and §103(a) have been properly traversed, accommodated, or rendered moot, and a full and complete response has been made to the outstanding Final Office Action mailed June 3, 2003. A Notice of Allowance is respectfully solicited. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

There should be no fee due in connection with the filing of this Response. However, should a fee be due which is not accounted for, such as a fee under 37 CFR §1.136, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

  
Hilmar L. Fricke  
Attorney for Applicant(s)  
Reg. No. 22,384  
Telephone: (302) 984-6058  
Facsimile: (302) 658-1192

Date:

594844v1

Sept 3, '03